

SERIAL NO. 10/734,788

REMARKS/ARGUMENTS

Claims 1-5, 8, 10-11 and 13 are currently a part of this application. Claims 15-21 were previously withdrawn. Claims 6, 9, 12 and 14 have been canceled by the present amendments. New claims 22-24 are provided herein. Support for the subject matter in claim 22 can be found in the specification on page 12, lines 20-22. Support for the subject matter in claim 23 can be found in the specification on page 7, line 25 through page 8, line 4. New claim 24 finds support in original claim 13.

A. Claim Rejection Under 35 U.S.C. § 102(e)

Claims 1-4, 6, 7 and 9-14 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. US 2002/0110679 to Miller et al. (hereafter "*Miller*"). The Examiner asserts that *Miller* discloses a "storm proof asphalt-based roofing material" which "includes a substrate coated with an asphalt coating, a protective coating, a layer of granules, and a web bonded to the lower region of the asphalt coating."

Miller does not teach an impact resistant roofing shingle according to the present invention having the following elements: (a) asphalt coated non-woven glass fiber substrate, (b) an exposed (or upper) surface of said substrate layered with granules, and (c) an unexposed (or lower) surface coated with an adhesive and laminated to an organic film.

SERIAL NO. 10/734,788

Rather, *Miller* requires an additional, protective coating (adhesive) on the upper surface of the asphalt coating and upon which granules are applied. (emphasis added). In the invention recited in the claims of the present application, the adhesive is coated on the asphalt on the unexposed or lower surface of the substrate and which is laminated to an organic film. (emphasis added).

According to paragraph [0047] of *Miller*, a protective coating (i.e., a polymeric material that functions as an adhesive, as recited in paragraph [0052]) is adhered to the upper surface of the asphalt coating and the granules are adhered to the protective coating. The shingle of the present invention does not include a protective layer of any type on the upper or exposed surface of the substrate. The exposed surface of the substrate of the present invention comprises only an asphalt layer and the granules are directly layered upon and/or embedded in the asphalt. As such, the present invention has eliminated the need for a protective coating on the asphalt coating layered on the upper surface of the substrate.

Additionally, *Miller*, in paragraph [0057] teaches that a web 132 is bonded to the substrate sheet prior to application of the asphalt coating. On the contrary, the shingle of the present invention features a substrate having an asphalt layer coated directly thereon. *Miller* further teaches that the web is fused with the asphalt coating (emphasis added). As recited in paragraph [0060] of *Miller*, a portion of the web and of the asphalt coating are intermingled by

SERIAL NO. 10/734,788

melting, thereby fusing the web and the asphalt coating. As discussed in paragraph [0061] of *Miller*, an interphase region 152 is formed by the intermingling of a portion of the web and the asphalt coating. The asphalt layer of the present invention does not “fuse” with the unexposed surface of the substrate; it simply adheres by the adhesive tackiness.

Accordingly, *Miller* does not teach each and every element of amended claim 1.

Applicants respectively request reconsideration of the Examiner’s rejection in view of the above response and the present amendment to claim 1. Therefore, in view of the above, Applicant submits that claim 1 is not anticipated. Since claims 2-4, 7 and 10, 11 and 13 depend directly or indirectly from amended claim 1, these claims incorporate all the limitations of amended claim 1 and are likewise not anticipated for the same reasons as asserted with regard to amended claim 1. Furthermore, since claims 6, 9, 12 and 14 have been canceled, the rejections thereto have thus been rendered moot.

B. Claim Rejections Under 35 U.S.C. § 103(a)

1. Claim 5 has been rejected in under 35 U.S.C. § 103(a) as being unpatentable over *Miller* (discussed above) in view of U.S. Pat. No. 4,636,414 to Tajima, et. al. (“*Tajima*”). According to the Examiner, *Miller* discloses the claimed invention except for the teaching that the organic film is a rubber polymer modified asphalt. The Examiner recites that *Tajima* teaches a rubber polymer modified asphalt and that it would have been obvious to one of ordinary skill in the art to have used *Tajima*’s rubber modified bitumen in place of the film layer of *Miller*.

SERIAL NO. 10/734,788

Claim 5 has been amended to recite that the adhesive is a rubber polymer modified asphalt. As recited above, the rejection recites that it would have been obvious to one of ordinary skill in the art to have used *Tajima's* rubber modified bitumen in place of the film layer of *Miller*. As amended, claim 5 recites an adhesive which is a rubber polymer modified asphalt, not an organic film. As such, there is no teaching or suggestion to combine the teaching of *Miller* with that of *Tajima* in order to arrive at the subject matter of amended claim 5.

Moreover, claim 5 depends directly from claim 1 and incorporates all the limitations of claim 1 therein. See *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) (If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious.) There is no teaching or suggestion in *Miller* alone, or in combination with *Tajima* directed to the impact resistant roofing shingle as recited in dependent claim 5.

2. Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Miller* (discussed above). The Examiner stated that *Miller* discloses the claimed invention except for the teaching that the polyester film is specifically a polyethylene terephthalate. According to the Examiner, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used polyethylene terephthalate as the polyester film in the *Miller* roofing material since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice.

SERIAL NO. 10/734,788

Applicants request reconsideration of this rejection. Claim 8 depends indirectly from claim 1 and incorporates all the limitations of claim 1 therein. As asserted above with regard to the rejection under 35 U.S.C. § 102, *Miller* does not recite each and every element as recited in amended claim 1, nor does *Miller* suggest an impact resistant roofing shingle having an asphalt coated non-woven glass fiber substrate, an exposed (or upper) surface of said substrate layered with granules, and an unexposed (or lower) surface coated with an adhesive and laminated to a polyethylene terephthalate organic film. As such, there is no teaching or suggestion in *Miller* directed to the impact resistant roofing shingle as recited in dependent claim 8. See *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) (If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious).

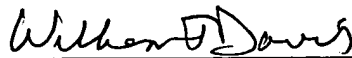
In view of the aforementioned remarks and amendments, the Applicants believe that each of the pending claims is in condition for allowance. If, upon receipt and review of this amendment, the Examiner believes that the present application is not in condition for allowance and that changes can be suggested which would place the claims in allowable form, the Examiner is respectfully requested to contact Applicant's undersigned counsel at the number provided below.

SERIAL NO. 10/734,788

Please charge any additional fees that may be due, or credit any overpayment of same, to
Deposit Account No. 50-1855.

Respectfully submitted,

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